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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/260,437	03/02/1999	JAY S. WALKER	WD2-98-116	6529

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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/260,437

Applicant(s)

WALKER ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 70-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 70-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the paper(s) filed 12/2/2002.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 10-34 and 70-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnsen (US5250789) in view of Gottlich et al (US6024288) and Folio 2/1/92 (Holiday gift subs up, some due to novel promotions). Johnsen teaches in column 9 lines 25-33, the concept of optically scanning a product at the POS, searching a database for any rebates that match the product, displaying a message offering a rebate and printing a rebate form. Gottlich et al states that it is known to issue a coupon/discount incentive at the checkout for a related item based upon the item currently being purchased. Gottlich et al provides examples of related products that would benefit from such incentive systems. Folio 2/1/92 teaches the idea of selling a product at a retail store, the product being a magazine subscription. It would have been obvious to have offered and created any type of coupon/rebate/savings incentive, including a rebate or discount for Folio 2/1/92's subscription purchase when a related "item" is scanned at the point of sale. This would enable subscription incentives to be offered and targeted to purchases of related products as well as provide incentives for

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consumers to purchase subscriptions which are not particularly selling well. It is taken to be inherent, if not obvious in Johnsen to have stored the necessary rebate information in the POS accessible database so that a customer could be informed of the corresponding subscription rebate when the related item is scanned and the associated rebate is communicated/offered to the customer. The printed rebate form would inherently include printed information about the rebate, including rebate identification so that it could be properly processed as is well known. Such printing or "coding"/"code" reads on the code of applicant's claims. Johnsen teaches printing such "code(s)", which inherently includes outputting a signal representing the code. The combination teaches outputting an offer for a discount in exchange for establishing a subscription when a related product is purchased. The coding/printing is specific to the particular rebate in the database and is selected from the totality of coding/printing associated with all of the stored rebate offers. It would have been obvious to one of ordinary skill at the time of the invention that the printing/coding of the rebate offer would include valid dates, productID, product description as well as contact info such as rebate provider, telephone help line, address, phone number, etc as is known with rebates. The printed rebate form is inherently a machine readable message (specific to the item), however, it would have been obvious to one of ordinary skill at the time of the invention to have provided the necessary info such as valid dates, productID, product description, etc as is known with rebates as bar-coded data so as to more efficiently enable processing.

Official Notice is taken that it is well known to pay for items at a POS by swiping a credit card. It would have been obvious to one of ordinary skill at the time of the invention to

have swiped a credit card for ease of payment. Such a credit card transaction inherently includes receiving an accountID. Claim 23 is met at least by the database search for a valid rebate (offer rebate if matching rebate is found). Regarding claim 31, the subscription package ultimately includes an issue of the magazine. Further, it would have been obvious to one of ordinary skill at the time of the invention to have bundled the subscription package with the current issue of the magazine to encourage impulse purchases for those who pick up and leaf through the current issue. Regarding claim 33 and 34, it would have been obvious to one of ordinary skill at the time of the invention to have provided text describing the magazine offer and/or numeric dates and/or numeric pricing with the printing/coding on the rebate form printout.

4. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnsen in view of Gottlich et al and Folio 2/1/92 as applied to claim 1 above, and further in view of Von Kohorn (US5759101). Von Kohorn teaches the use of codes printed on coupons including dates, terms of redemption, product and a validation code to verify authenticity. It would have been obvious to one of ordinary skill at the time of the invention to have provided these and/or other related codes/printing with the rebate form of Johnsen to convey the details of the offer and to enable authenticity and prevent fraud. It would have been obvious to one of ordinary skill at the time of the invention to have created authenticity coding by any known means including random code generation or encryption of code attributes, so as to prevent fraud or reverse-engineering of coupons and enable authenticity as desired by Von Kohorn.

5. Claims 5-9 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Johnsen in view of Gottlich et al and Folio 2/1/92 as applied to claim 1 above, and further in view of Flaten (US5467269). Flaten teaches in column 2 lines 46-56 the use of codes printed on coupons or rebate forms such as productID, storeID, manufacturerID, retailerID, etc to supply valuable marketing and routing information to the system. It would have been obvious to one of ordinary skill at the time of the invention to have provided these and/or other related codes/printing with the rebate form of Johnsen.

Response to Arguments

6. Applicant argues that there is no teaching to offer a rebate in exchange for establishing a subscription. As stated above, Gottlich et al states that it is known to issue a coupon/discount incentive at the checkout for a related item based upon the item currently being purchased. Folio 2/1/92 teaches the idea of selling a product at a retail store, the product being a magazine subscription. It would have been obvious to have offered and created any type of coupon/rebate/savings incentive, including a rebate or discount for Folio 2/1/92's subscription purchase when a related "item" is scanned at the point of sale.

Applicant argues that no codes are generated when an associated rebate is identified. Johnsen teaches searching for associated rebate, display of rebate

opportunity and printing of the rebate. The printing of the rebate offer is taken to inherently include code which describes the offer.

Applicant argues that Johnsen does not provide a rebate at the POS. Gottlich et al however teaches rebates at POS.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc
December 13, 2002